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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/534,433 03/23/00 PATTON

D 80521F-P

001333
PATENT LEGAL STAFF
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QM22/0801

EXAMINER

HENDERSON, M

ART UNIT

PAPER NUMBER

3722
DATE MAILED:

08/01/01

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/534,433

Applicant(s)

David L. Patton

Examiner

Mark T. Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Jul 2, 2001

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 12-33 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 12-16, 19, 20, 23-27, 30, and 31 is/are rejected.

7) ☒ Claim(s) 17, 18, 21, 22, 28, 29, 32, and 33 is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6

20) ☐ Other:

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXING of responses to Office Actions directly into the Group at (703)305-3579. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Objections

2. Claims 16 and 27 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to

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cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 16 and 27 disclose the same limitations as that written in the independent claims 12 and 23.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 12-16, 19, 20, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Dlugos et al (6,112,193).

Dlugos et al discloses in Fig. 5, a stamp (75) comprising a first indicia (37) which is visible, and a second indicia (4) which may be invisible. The second indicia (4) may also be divided into portions which may or may not be visible. This portion can be considered a third indicia.

However, Dlugos does not disclose a unique ID identifying stamp out of a predetermined limited amount, a third indicia identifying a printer or location of where stamp was printed.

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In regards to **Claims 12, 13, 15, 19**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any desired indicia, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate.

In regards to **Claims 19 and 20**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any number of indicia portions, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

4. Claims 23-27, 30 and 31, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Brasington et al in view of Dlugos et al.

Brasington et al discloses in Fig. 5 and 8, a sheet of stamps, wherein each stamp comprises a first visible indicia (69), a second indicia (73), and a third indicia (71) provided for identifying the vendor/printer machine (Col. 5, lines 11-34) and location.

However, Brasington does not disclose a second and third indicia that is not visible.

Dlugos et al discloses in Fig. 5, a stamp (75) comprising a first indicia (37) which is visible, and a second indicia (4) which may be invisible. The second indicia (4) may also be

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divided into portions which may or may not be visible. This portion can be considered a third indicia.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Brasington et al's stamp sheet to include stamps having indicia which is invisible, as taught by Dlugos et al for the purpose indicating whether a mail piece has been scanned.

In regards to **Claims 23, 24, and 26**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any desired indicia, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate.

In regards to **Claims 30 and 31**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any number of indicia portions, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

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Allowable Subject Matter

5. Claims 17, 18, 21, 22, 28, 29, 32 and 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

6. Applicant's arguments with respect to claim 12-33 have been considered but are moot in view of the new ground(s) of rejection.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)305-3579. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

July 27, 2001



WILLMON FRIDIE, JR.
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